



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,591	02/04/2004	John R. Maddison	046124-5314	2336
55694	7590	04/28/2008	EXAMINER	
DRINKER BIDDLE & REATH (DC)				SETH, MANAV
1500 K STREET, N.W.				
SUITE 1100				
WASHINGTON, DC 20005-1209				
				2624
ART UNIT		PAPER NUMBER		
MAIL DATE		DELIVERY MODE		
04/28/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/772,591	MADDISON, JOHN R.	
	Examiner	Art Unit	
	MANAV SETH	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 January 2008.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-4 and 6-12 is/are rejected.
 7) Claim(s) 5 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>01/08/2008</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 8, 2008 has been entered.

Information Disclosure Statement (IDS) filed after Allowance

2. Information disclosure statement (IDS) filed on January 8, 2008 after allowance has been considered and entered in full.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

Art Unit: 2624

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-4 and 6-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13-45 of copending Application No. 11/889,787 (US Publication No 2008/0055405 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Regarding claims 1, 11 and 12, Maddison (2008/0055405) discloses “a method for determining a position of an area of an object within said object, wherein an image of said area of said object is contained within a field of view of a microscope, and wherein image data representing a low magnification image of the complete object is available, the method comprising the steps of” acquiring high magnification image data representing an image of the field of view of the microscope” (claim 13, page 4, right column, last 9 lines); processing the high magnification image data to reduce the resolution thereof; comparing the processed high magnification image data with portions of the low magnification image data and determining said position based on the results of said comparison (claim 13, page 5, left column, lines 1-20) and further see claims 37 and 45.

Regarding claim 2, Maddison discloses “a method as claimed in claim 1, in which the comparison determines a percentage of identical data in each compared portion of the low magnification image data and the processed high magnification image data (claim 28, page 5, right column).

Regarding claim 3, Maddison discloses “a method as claimed in claim 1, in which a position is determined if the determined percentage of identical data for at least one portion of the low magnification image data exceeds a predetermined threshold (claim 14).

Regarding claim 4, Maddison discloses “a method as claimed in which the step of determining said position based on the results of said comparison comprises determining the position as the position of the, or one of the, at least one portion of the low magnification image data (claims 23 – 26).

Regarding claim 6, Maddison discloses “a method as claimed in claim 1, in which the processing comprises reducing the resolution by a pre-determined amount” (claim 29).

Regarding claim 7, Maddison discloses “a method as claimed in claim 6, in which the predetermined amount is a factor determined by calibration of an apparatus from which the low magnification image data is acquired, and calibration of the microscope (claim 31).

Regarding claim 8, Maddison discloses “a method as claimed in claim 1, further comprising displaying an image of the complete object and of the field of view of the microscope on a display

screen, and highlighting the area of the image of the complete object corresponding to the determined position (claims 17-20).

Regarding claim 9, Maddison discloses “a method as claimed in claim 1, further comprising, initially acquiring said low magnification image data from a high resolution image data source (claim 33).

Regarding claim 10, Maddison discloses “a method as claimed in claim 9, wherein the image data source is one of a scanner, digital photocopier and a high resolution digital camera (claim 35).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1-12 would be allowable after double patenting issues have been resolved.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manav Seth whose telephone number is (571) 272-7456. The examiner can normally be reached on Monday to Friday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta, can be reached on (571) 272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Manav Seth/

Examiner, Art Unit 2624

Manav Seth
Art Unit 2624
April 7, 2008

/Bhavesh M Mehta/
Supervisory Patent Examiner, Art Unit 2624